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EXAMINER

WEINSTEIN, STEVEN L

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974633

Applicant(s)

PALMER ET AL

Examiner

S. WEINSTEIN

Group Art Unit

1761

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- ☐ Of the above claim(s) 12-14 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 243
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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Restriction to one of the following inventions is required under 35 USC 121.

Group I, claims 1-11, drawn to an apparatus for decorating an edible classified in class 426, subclass 112.

Group II, claims 12-15, drawn to a method of decorating a food, classified in class 426, subclass 383.

Group III, claim 16, drawn to a nib, classified in class 401.

The inventions are distinct, each from the other because the apparatus as claimed in Group I could be used in methods other than that recited in Group II. For example, the apparatus could be used to mark inedible surfaces. Also, the nib as recited in Group III, could be used with a marker that can contain inedible ink.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art requiring separate searches as shown by their different classification, restriction for examination purposes as indicated is proper.

In a telephone conversation with Mr. Lampe on May 6, 2003, the invention of Group I, claims 1-11 was elected with traverse. Claims 12-16 are withdrawn from further consideration as being drawn to non-elected inventions.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naor et al (6,299,374) in view of Kiryu (Jp 52-143118), Sailor Pen (Germ. 2555391),

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Shion Kagaku (Jp 54-8020), Pentel (Jp 60-255837), Pentel (Jp 7-188600), Nable (DE 3135800), Wagner Pelikan (Germ. 2535906) or Kiryu et al etc. in view of Naor et al, both further in view of Williamson (3446143).

In regard to claim 1, Naor et al discloses an apparatus for decorating an edible food product comprising a hand held container defining an interior holding a liquid decorating substance for decorating a food and an elongated nib connected to the hand held container, said nib having a porous distal end and an interior defining voids (the felt or other material would inherently have voids) in fluid flow communication with the interior of the container so that the liquid decorating substance can be conveyed to the distal end. Claim 1 also recited functionally that the nib readily laterally flexes when in contact with the food when pressure is exerted to substantially prevent deformation of the food, even when the edible food is soft and the pressure is slight. Naor et al does not disclose how flexible the nib is so that it is not clear whether the nib of Naor et al meets this functional recitation of a property or not. However, Naor et al discloses unequivocally that the marker can be used to decorate frosting and/or icing (e.g., col. 7, para. 4), and that the markers can be used to write on whipped cream or frosting without bleeding (e.g., col. 8, para. 3). Since Naor et al discloses that the marker can be used to write on frosting, icing and even whipped cream, it would appear that the nib of Naor et al would have to have the functionally recited flexibility or, at least, the nib would be allowed to write on such surfaces without "substantially" deforming those disclosed surfaces which are a lot more delicate than, say, a hard cookie surface. There is certainly no disclosure in Naor et al that the marker, and specifically the nib,

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can potentially damage any food surface, whether the surface is hard or soft. In any case, as evidenced by Kiryu, Sailor Pen, Shion Kagaku, Pentel ('837), Pentel ('600), Nable and Wagner Pelikan, it is notoriously old in the art to provide markers with foamed nibs and specifically, open celled foam nibs, which foamed nibs, will inherently be flexible. The foam would have to be open celled; otherwise it would not be porous and thus fluid conveying. Sailor Pen, e.g., discloses flexible, bendable plastic foam and Pentel ('837) discloses high-resilience open celled foam (claim 2). To modify Naor et al and substitute one conventional nib material for another conventional nib material, if indeed the nib of Naor et al is not flexible, would have been obvious especially since Williamson further teaches to employ resilient foamed surfaces to impart edible ink to delicate icing surfaces to prevent damage to the icing surfaces. Similarly, since Kiryu, as further evidenced by Sailor Pen, Shion, etc., teach hand held markers with flexible foamed nibs and since Naor et al discloses it was conventional to employ edible liquid decorating substance so that it would have been obvious to modify Kiryu as further evidenced by Sailor Pen, etc. and substitute one conventional marking substance for another conventional marking substance especially since Williamson teaches the advantages of a resilient foam marking surface. In regard to claim 3, the particular conventional open celled foam material used is seen to have been an obvious routine determination. Kiryu, eg. discloses open celled polyvinyl alcohol and Shion Kagaku mentions acetalising polyvinyl alcohol. In regard to claims 4 and 5, the open celled foam nibs of the art taken as a whole would be hydrophilic and use capillary action. In regard to claim 6, Naor et al shows a concave taper decreasing to the marking end as

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does Sailor Penn ('391). In regard to claims 8-11, since the art is replete with foamed nibs, the particular porosity, pore size and water absorption rate, if not inherent in these references would have been an obvious determination since they are all used to transfer a liquid marking substance.

The remainder of the references cited on the USPTO 892 forms are cited as art of interest.

Any inquiry concerning this communication from the examiner should be directed to Steven Weinstein whose telephone number is 703-308-0650. The examiner can generally be reached on Monday-Friday 7:00am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0661.

S. Weinstein/mn
May 20, 2003

STEVE WEINSTEIN 1761
PRIMARY EXAMINER
5/21/03